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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,471	06/25/2003	Larry Gause	MSDI-259/PC757.00	3218

52196 7590 03/16/2010
MEDTRONIC
Attn: Noreen Johnson - IP Legal Department
2600 Sofamor Danek Drive
MEMPHIS, TN 38132

EXAMINER

RAMANA, ANURADHA

ART UNIT	PAPER NUMBER
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3775

MAIL DATE	DELIVERY MODE
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03/16/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/603,471	Applicant(s) GAUSE ET AL.	
	Examiner Anu Ramana	Art Unit 3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,11-38,59-62,81,82,87 and 89-93 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,11-38,59-62,81,82,87 and 89-93 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In view of the Arguments presented in the Appeal Brief submitted on,
PROSECUTION IS HEREBY REOPENED. To avoid abandonment of the
application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111; or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by
an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and
appeal brief fee can be applied to the new appeal. If, however, the appeal fees set
forth in 37 CFR 41.20 have been increased since they were previously paid, then
appellant must pay the difference between the increased fees and the amount
previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by
signing below:

/Thomas C. Barrett/
Supervisory Patent Examiner, Art Unit 3775

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that
form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public
use or on sale in this country, more than one year prior to the date of application for patent in the United
States.

Claims 36-38 are rejected under 35 U.S.C. 102(b) as being anticipated by
Coates et al. (US 5,423,826).

Coates et al. disclose a plating system including: a plate 22 with two bone fastener holes; a holding instrument including an actuating system having a movable linkage member 152 and a stationary linkage member 151; first and second holding members 157 coupled to the stationary and linkage members, respectively, wherein the holding members are movable along the longitudinal axis due to the presence of hinge connections (164, 165); and a guide mechanism including a guide member 180 spaced proximally from the plate when the holding system is engaged with the plate and a laterally extending alignment member 159 (Figs. 10, 14, 17 and 19, col. 10, lines 36-68, col. 11, lines 1-48, col. 12, lines 67-68 and col. 13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 11-14, 18, 20-27, 81-82, 87, 92 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haider (US 2003/0105462 A1) in view of Theken et al. (US 6228085).

Haider discloses an elongate bone plate including an opening or “a visualization opening” having an hourglass shape with convexly and concavely curved side walls (Fig. 2 and paras [0027]-[0034]).

Haider discloses all elements of the claimed invention except for the claimed widths and length-to-width ratios.

Theken et al. teach adjusting the shape of an observation window or visualization opening in a plate for interoperative graft access and for postoperative graft evaluation (col. 4, lines 67 and col. 5, lines 1-23).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have adjusted the size and shape of the visualization opening of Haider, as taught by Theken et al., for interoperative graft access and postoperative graft evaluation.

Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to arrive at the claimed widths and length-to-width ratios, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 59-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haider (US 2003/0105462 A1) in view of Theken et al. (US 6228085) further in view of Boucher et al. (US 6514274).

The combination of Haider and Theken et al. disclose all elements of the claimed invention except for the plate being made of a material that is translucent.

Boucher et al. teach making a plate of a translucent material to enable visual alignment of the plate with holes in the underlying bone (col. 4, lines 14-30).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the plate of the combination of Haider and Theken et al. of a translucent, material as taught by Boucher et al., to enable visual alignment of the plate with underlying bone holes.

Claims 1, 11-15, 18-27, 81-82, 87, 92 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lyons et al. (US 6413259) in view of Theken et al. (US 6228085).

Lyons et al. disclose a bone plate 12 including a visualization openings 28; first and second anchors 22 on each side of the visualization openings; and retaining

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devices 22 to prevent the bone anchors from backing out of the plate (Figs. 1-3, col. 4, lines 43-67, cols. 5-6 and col. 7, lines 1-36).

Lyons et al. disclose all elements of the claimed invention except for: (1) the curvatures of the side walls of the visualization opening; and (2) the widths and length-to-width ratios of the visualization opening.

Theken et al. teach adjusting the shape of an observation window or visualization opening in a plate for intraoperative graft access and for postoperative graft evaluation (col. 4, lines 67 and col. 5, lines 1-23).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have adjusted the size and shape of the visualization opening of Lyons et al., as taught by Theken et al., for intraoperative graft access and postoperative graft evaluation.

Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to arrive at the claimed widths and length-to-width ratios, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lyons et al. (US 6413259) in view of Theken et al. (US 6228085) further in view of Haider (US 2003/0105462 A1).

The combination of Lyons et al. and Theken et al. disclose all elements of the claimed invention except for a specific reference to an hour-glass shape of the visualization opening. It is noted that Theken et al. disclose providing a visualization opening that narrows inward toward the center region to allow visualization of the edges of a graft (col. 5, lines 12-14).

Haider discloses an elongate bone plate including an opening or “a visualization opening” having an hourglass shape with convexly and concavely curved side walls (Fig. 2 and paras [0027]-[0034]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a visualization opening that has an hourglass shape, since this is a well known shape that narrows inward toward the center region of the hole, as demonstrated by Haider.

Claims 16-17, 28-35 and 89-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lyons et al. (US 6413259) in view of Theken et al. (US 6228085) further in view of Michelson (US 6,193,721).

Lyons et al. disclose all elements of the claimed invention except for: (1) the claimed shape of the visualization opening; and (2) a holding instrument to hold the plate.

Theken et al. teach adjusting the shape of an observation window or visualization opening in a plate for interoperative graft access and for postoperative graft evaluation (col. 4, lines 67 and col. 5, lines 1-23).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have adjusted the size and shape of the visualization opening of Lyons et al., as taught by Theken et al., for interoperative graft access and postoperative graft evaluation.

The combination of Lyons et al. and Theken et al. disclose all elements of the claimed invention except for a holding instrument to hold the plate.

Michelson teaches a type of plate holder to hold a plate in position wherein the plate holder has an actuating system; first and second holding members wherein one is holding member is stationary and the other is movable to selectively engage the plate; and a guide mechanism including a guide member 54 positioned relative to the plate

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(Figs. 38 and 39, col. 20, lines 48-53, col. 21, lines 56-67 and col. 22, lines 1-51). It is noted that the proximal portion of movable arm 130 constitutes a linkage

Therefore, it would have been obvious to one of ordinary skill in the art to have utilized a plate holder as taught by Michelson to hold the Lyons et al. plate since it was well known in the art to use a plate holder to position a plate against bone.

Claims 59-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over in Lyons et al. (US 6,413,259) in view of Theken et al. (US 6228085) further in view of Boucher et al. (US 6,514,274).

The combination of Lyons et al. and Theken et al. disclose all elements of the claimed invention except for the plate being made of a material that is translucent. See previous discussion.

Boucher et al. teach making a plate of a translucent material to enable visual alignment of the plate with holes in the underlying bone (col. 4, lines 14-30).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the plate of the combination of Lyons et al. and Theken et al. of a resorbable translucent material as taught by Boucher et al., to enable visual alignment of the plate with underlying bone holes.

Response to Arguments

Applicant's arguments presented in the Appeal Brief filed on July 16, 2009 have been carefully considered by the Examiner.

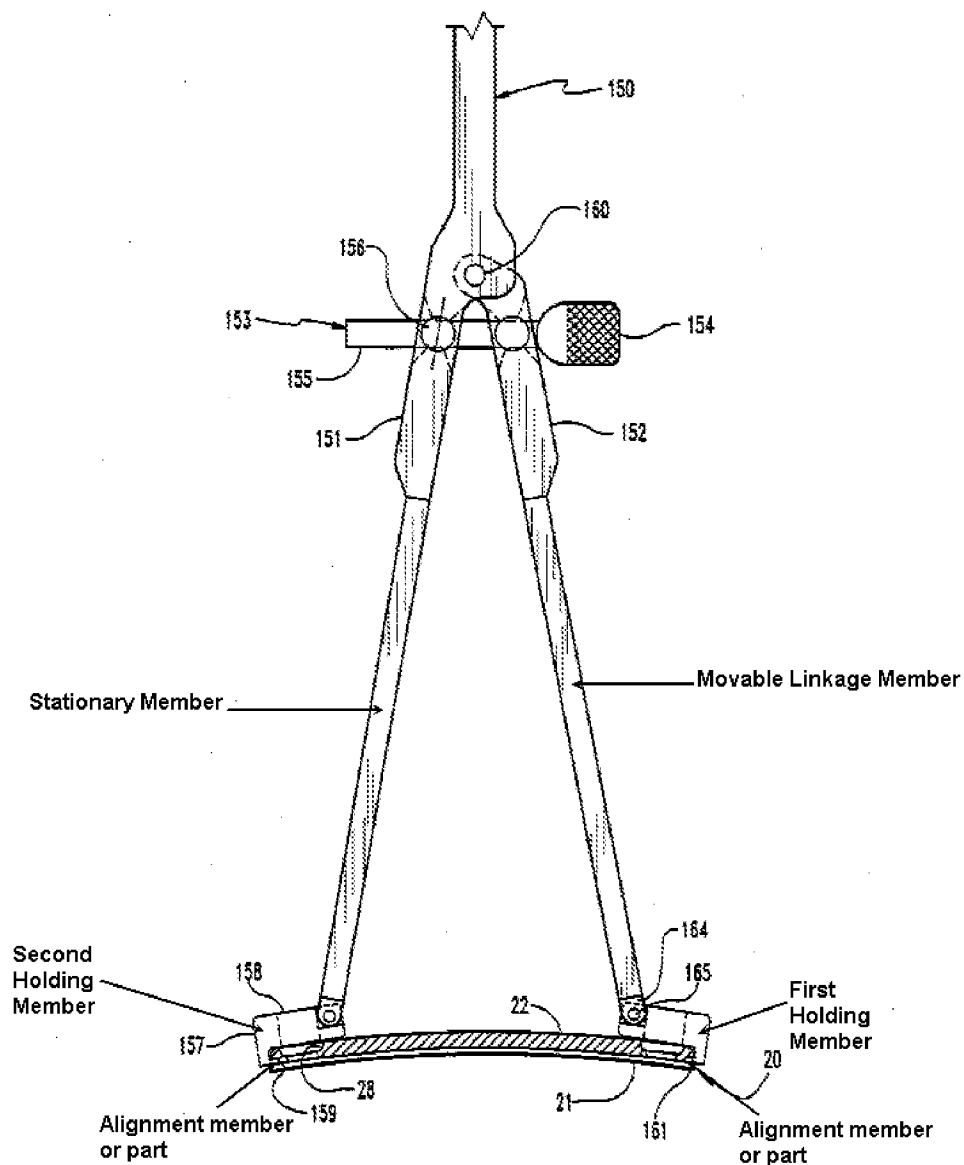
New rejections have been made to provide a reason why those of ordinary skill in the art would have adjusted the shape and size of a visualization opening in a bone plate.

Applicant's arguments with respect to the rejections of claims 36-38 under 35 USC 102(b) over Coates et al. (US 5,423,826) have been considered but are not found

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to be persuasive because Coates et al. discloses all elements of Applicant's claimed invention as illustrated in marked up Fig. 17 of Coates et al. (see following page).

Guide member 180 is mounted to the stationary member when received in the second holding member. It is noted that Applicant is not claiming the guide member to be directly mounted to the stationary member. It is the Examiner's position that the recitation "mounted proximally of said holding system" only requires a portion of the guide member to be proximal to the holding system, i.e., the first and second holding members. The recitation "to guide placement of a bone-engaging fastener" is functional and only requires guide member 180 to be capable of receiving a bone fastener. In order to be given patentable weight, a functional recitation must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. In re Fuller, 1929 C.D. 172; 388 O.G. 279.



Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached at (571) 272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR

March 1, 2010

/Anu Ramana/

Primary Examiner, Art Unit 3775